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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,081	02/27/2004	Thomas Ellinger	15111.0080	8803
27890 7590 10/25/2007 STEPTOE & JOHNSON LLP 1330 CONNECTICUT AVENUE, N.W. WASHINGTON, DC 20036			EXAMINER CROW, ROBERT THOMAS	
			ART UNIT 1634	PAPER NUMBER
			MAIL DATE 10/25/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/789,081

Applicant(s)

ELLINGER ET AL.

Examiner

Robert T. Crow

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 October 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): The rejection of claims 62-86 under 35 USC 112, Second Paragraph.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: None.
Claim(s) objected to: 7.
Claim(s) rejected: 1-25, 52-58 and 62-89.
Claim(s) withdrawn from consideration: None.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____

/Jehanne Sitton/
Primary Examiner
10/23/2007

Continuation of 3. NOTE: The amendments filed 5 October 2007 further limit the array of claim 1 to have a cleaving solution in contact with the cleavage products. This limitation further narrows the scope of the claims, and thus requires further search and consideration because the claims now require this additional limitation. This new limitation was not present in claims at the time of the final rejection and therefore will not be searched.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant argues on pages 13-22 of the Remarks filed 5 October 2007 that claims 62-86 are not indefinite because at the first instant and for some time after contacting with a cleavage solution, at least some of the probe molecules in contact with the cleaving solution will remain uncleaved.

Applicant's arguments are found persuasive, and the rejection is therefore withdrawn. However, it is noted that Applicant admits that a cleavage solution in contact for a hybridized array, if only for "the first instant" and wherein "fewer than all selectively cleavable bonds will be cleaved" as argued on page 14 of the Remarks, meets the limitations of the claims.

Applicant's arguments on pages 14-15 of the Remarks regarding the rejections of claims 1-16 and 87-89 as anticipated by Koster et al refer to the amended claims and rely solely on the amendments. Since the after final amendments were not entered, the arguments are moot, and have, therefore, not been considered.

Applicant argues on page 16 of the Remarks that Monforte et al does not teach the probes are bound to the target molecules and in contact with a cleaving solution because columns 5 and 15-16 teach the target is denatured from the array before contacting with a cleaving solution.

However, Monforte et al teach a first single exemplary embodiment wherein immobilized primers comprising cleavable sites are annealed to a target, extended, immobilized, and cleaved with an optional washing step (column 4, line 30-column 5, line 5). Other than a recitation of denaturation specifically as part of PCR protocols in the "Background" section of Monforte et al (column 3, lines 35-50), the first recitation of denaturation as part of an embodiment of the invention of Monforte et al is in column 5, lines 25-35. The embodiment describing denaturation is separated from the first single exemplary embodiment (column 4, line 30-column 5, line 5) by the phrase "[i]n one embodiment" in line 6 of column 5 and by a subsequent recitation of "[i]n this aspect of the invention" in line 15 of column 5. the two recitations clearly indicate these embodiments are alternate embodiments to that depicted in column 4, line 30-column 5, line 4, wherein cleavage takes place with no denaturation step. thus, Monforte et al teach the cleavage solution is in contact with the hybridized probe array.

Applicant argues on page 17 of the Remarks that Fung et al do not teach anchor groups in accordance with page 40 of the instant specification.

However, this argument is confusing because paragraph 0091 of the instant specification recites an embodiment wherein a detectable unit is a fluorophore, and an anchor group is a group wherein the detectable unit is coupled. Applicant's citation of page 40 recites an embodiment wherein the anchor group is reacted with specifically binding components, which is a different embodiment of an anchoring group compared to that of paragraph 0091. Fung et al teach anchoring groups in the form of linkers which are attached to fluorescent labels to nucleic acids (Abstract). The linkers of Fung et al are thus "anchors" in accordance with paragraph 0091 of the instant specification, and the claim has been given the broadest reasonable interpretation consistent with the teachings of the specification regarding "anchors" (In re Hyatt, 211 F.3d1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000) (see MPEP 2111 [R-1])).

Applicant argues on page 18 of the Remarks that Lockhart et al does not teach labeled probes are immobilized.

As noted in the previous Office Action, Lockhart et al is solely relied upon for the third through fifth probes. Monforte et al already teach labeled immobilized probes (column 9, lines 5-10); thus, Monforte et al teach provide a teaching of immobilized labeled probes, and no teaching of immobilization is required by Lockhart et al.

Applicant argues on page 19 of the Remarks that Mackay et al does not teach a cleavage product of a probe molecule immobilized at a defined site.

However, this argument is confusing because Mackay et al is relied upon for an array element having a detectable unit that is not linked to a probe molecule. Thus, no cleavage product, in particular, no probe molecule, is required by the claim.

Applicant argues on page 20 of the Remarks that Kievits et al do not teach the differing labeling degree of the instant claims.

However, Applicant cites the specification for a definition of a different of degree of labeling as "for example with a defined mixture...." The phrase "for example" indicated the recitation is to a single embodiment, and not a limiting definition. Kievits et al teach a differing degree of labeling as detailed in the previous Office Action. Because Applicant's citation is not a limiting definition, the claim has been given the broadest reasonable interpretation consistent with the teachings of the specification regarding a "differing degree of labeling."

Applicant's remaining arguments rely on the alleged deficiencies of the prior art that are rebutted above. Since the arguments regarding the alleged deficiencies were not persuasive, the rejections of the remaining claims are maintained.